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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,411	07/05/2001	Rolf Meyer	GK-EIS-1040 / 500593.2003	8730
26418	7590	06/02/2004	EXAMINER	
REED SMITH, LLP ATTN: PATENT RECORDS DEPARTMENT 599 LEXINGTON AVENUE, 29TH FLOOR NEW YORK, NY 10022-7650			BANGACHON, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2635	12

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/806,411	MEYER ET AL.
	Examiner	Art Unit
	William Bangachon	2635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-8, 11-17 and 19-21 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Response to Arguments***

1. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that "the substitute specification should be examined rather than the original claims contained in the English translation" [page 7, 2<sup>nd</sup> paragraph]. The Examiner disagrees in that, **the substitute specification is improper and the inclusion of claims in the substitute specification is improper**. 37 CFR 1.125 states (note: the underlined and bold lettering as a basis of improper substitute specification):

#### **Substitute specification.**

- (a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.
- (b) A substitute specification, excluding the claims, may be filed at any point up to payment of the issue fee if it is accompanied by:
  - (1) A statement that **the substitute specification includes no new matter**, and
  - (2) **A marked up version of the substitute specification showing all the changes** (including the matter being added to and the matter being deleted from) to the

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specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.

(c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).

(d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding

Second, **the claims in the substitute specification are improper**. 37 CFR 1.121(c) states that.

(c) **Claims.** Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently

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amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim, which was previously canceled, may be reinstated only by adding the claim as a "new" claim with a new claim number.

The claims are amended without any indicating that the claims are amended and what was amended. As indicated by Applicant, **the claims in the substitute specification have been amended to conform to U.S. practice [pg. 7, 5<sup>th</sup> paragraph].** Therefore, examination of the original claims (English translation) is proper under 37 CFR 1.125 and 37 CFR 1.125.

NOTE: The claims included in the substitute specification are not entered.

Applicant argues that "the language of claims 8, 9, and 18 have been incorporated into claims 1 and 11, and since claims 8, 9, and 18 have not been addressed by the Examiner, the rejection to claims 1 and 11 are considered moot..." [pg. 7, last paragraph]. The Examiner respectfully traverses applicant's arguments in

that the scope of the incorporated language to claim 1 has changed. i.e. "**each transmitter transmits information which is associated to events which may occur in the respective information cell**" is not recited in any of claims 8 or 9. Claims 8 and 9 pertain to the 'location' and not 'events', which may occur in the respective information cell.

2. Applicant's arguments with respect to claims 1-8, 11-17, and 19-21, have been considered but are moot in view of the new ground(s) of rejection. Rejection to claims 1-8, 11-17, and 19-21, is maintained in this Office action.

NOTE: Although the current claim amendment is improper under 37 CFR 1.121(c), current claims 1-8, 11-17, and 19-21, will be considered, for examination purposes. Rejection to claims 1-8, 11-17, and 19-21, is based on the current claim amendment.

### ***Specification***

3. Objection to the abstract is withdrawn.

### ***Claim Objections***

4. Claims 6-10 and 16-21 has been amended to conform to US practice and therefore objection to claims 6-10 and 16-21 under 37 CFR 1.75(c) as being in improper form, is withdrawn.

5. Objection to claim 1 is withdrawn.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 1-8, 11-17, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,889,473 (Wicks).

In claims 1 and 6-7, Wicks teaches of an information system for supplying a predetermined region with information {col. 2, line 36-col. line 2}, comprising:

a transmitter (10, 13, 14, 43) for transmitting information in digitally coded form {col. 4, lines 18-65},

hand-held device (15, 40) {col. 2, lines 29-35; col. 3, lines 3-27}, which comprises receiver (42) for receiving the information transmitted by the transmitter,

a digital memory device (47) for storing the information received,

a reproduction device (24) for reproducing the memorized information, in particularly acoustically and/or optically, and

an event detection device (41) for detecting specific events, wherein, upon the detection of an event from the stored information, the stored information which is assigned to the detected event is selected for reproduction

wherein a region/service area includes a plurality of information cells (13, 14) {col. 4, lines 18-37} and the transmitter is located in each information cell, and each transmitter transmits information which is associated to events which may occur in the respective information cell {col. 4, lines 59-65; col. 5, lines 1015, lines 24-30}.

In claim 2, an information system according to Claim 1, characterized in that the transmission of the information from the transmitter to the receiver takes place more quickly than a subsequent reproduction by the reproduction device {col. 2, lines 17-29; col. 5, lines 23-30}.

In claim 3, an information system according to Claim 1 or 2, characterized in that the information is multilingual {col. 2, lines 29-35; col. 5, lines 16-22}.

In claim 4, an information system according to Claim 3, characterized in that the hand-held device comprises a selection device for selecting one of the languages in which the information is transmitted {col. 3, lines 10-15}.

In claim 5, an information system according to Claim 4, characterized in that only the information which comprises the language selected by means of the selection device is stored in the memory device of the hand-held device {col. 2, lines 29-35; col. 5, lines 23-30}.

In claim 8, an information system according to Claim 7, wherein the signal generators (13, 14) are formed by infrared transmitters and/or induction transmitters, each emitting a signal characterizing the location {col. 1, lines 4-9}.

Claims 11-17 and 19-21 recites a method for practicing the system of claims 1-8 and therefore rejected for the same reasons.

8. Claims 1-8, 11-17 and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,313,735 (Higuchi) in view of US 5,889,473 (Wicks).

In claims 1, 6-8, Higuchi teaches of an information system for supplying a predetermined region with information {see whole document}, comprising:

a transmitter for transmitting information in digitally coded form {col. 1, lines 48-52; col. 2, lines 40-45; col. 3, lines 6-15},  
hand-held device (figures 2 and 15), which comprises  
receiver (1, 2) for receiving the information transmitted by the transmitter,  
a digital memory device (11) for storing the information received,  
a reproduction device (8) for reproducing the memorized information, in  
particularly acoustically and/or optically, and  
an event detection device (3) for detecting specific events, wherein, upon  
the detection of an event from the memorized information, the information which  
is assigned to the detected event is selected for reproduction.

Higuchi does not expressly disclose "wherein a region/service area includes a **plurality of information cells** (Wicks, 13, 14) {Wicks, col. 4, lines 18-37} and the transmitter is located in each information cell, and each transmitter transmits information which is associated to events which may occur in the respective information cell" {Wicks, col. 4, lines 59-65; col. 5, lines 1015, lines 24-30}. As evidenced by Wicks, these claim limitations are conventional {Wicks, col. 1, lines 25-30; col. 4, lines 28-37}. Since the strength of transmission from a pager is constrained by the battery power available to the pager, the information cells must be sufficient in number and distribution to receive pager transmissions. This is clearly desirable in the system of Higuchi for the multilingual pager of Higuchi to be used anywhere. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to have a plurality

of information cells in the system of Higuchi, for receiving tourist information (as claimed), as evidenced by Wicks, because the strength of transmission from a pager is constrained by the battery power available to the pager.

In claim 2, an information system according to Claim 1, characterized in that the transmission of the information from the transmitter to the receiver takes place more quickly than a subsequent reproduction by the reproduction device {col. 1, lines 48-52; col. 2, lines 40-45}.

In claim 3, an information system according to Claim 1 or 2, characterized in that the information is multilingual {col. 3, lines 37-47}.

In claim 4, an information system according to Claim 3, characterized in that the hand-held device comprises a selection device for selecting one of the languages in which the information is transmitted {col. 4, lines 17-30}.

In claim 5, an information system according to Claim 4, characterized in that only the information which comprises the language selected by means of the selection device is stored in the memory device of the hand-held device {col. 4, lines 33-41}.

Claims 11-17, 19-21, recite a method for practicing the system of claims 1-8 and therefore rejected for the same reasons.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Examiner Contact Information***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bangachon whose telephone number is 703-305-2701. The examiner can normally be reached on 4/4/10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 703-305-4704. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9314

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for regular and After Final formal communications. The examiner's fax number is 703-746-6071 for informal communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

William L Bangachon  
Examiner  
Art Unit 2635

May 26, 2004

MICHAEL HORABIK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

